

REMARKS

In sections 2-3 of the Office Action, the Examiner rejects claims 85, 88, 90 and 91 under 35 USC 102(b) as being anticipated by Dolowy et al. (US Patent No. 4,259,112). Moreover, in section 4, claims 72-94 are rejected under 35 USC 103(a) as being unpatentable over Corbett et al. (US Patent No. 5,133,057) in view of Dolowy et al. These rejections are respectfully traversed.

Dolowy et al. and Corbett et al., standing alone or in combination, fail to disclose, teach, or suggest, *inter alia*, the following features recited by the claimed invention:

claim 72: "impregnating the graphite with a polymer containing a metal powder".

claim 85: "impregnating the graphite with a molten polymer containing a high temperature alloy powder".

In section 6, the Examiner admits that Dolowy fails to disclose "impregnating the graphite with a polymer containing a metal powder". However, the Examiner cites MPEP 2113 and *In re Marosi*, and asserts that "once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product." The Examiner implies that he has provided a rationale showing that the claimed product appears to be the

same or similar to that of the prior art. The Applicant respectfully disagrees.

First of all, the Applicant believes that the Examiner does not interpret *In re Marosi* correctly. *In re Marosi* states (at the paragraph bridging page 292 and 293 at U.S. Patent Quarterly, Vol. 218) that “[w]here a product-by-process claim is rejected over a prior art product that appears to be **identical**, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”. Note that “to be identical” is a higher requirement than “appears to be the same or similar”.

Secondly, the Examiner does not show that the products in Dolowy or Corbett are “identical” or “same or similar” with that of the claimed invention. Dolowy teaches a process for producing composite materials comprising a metal matrix with reinforcing fibers. However, **there is no evidence (for example, drawings) or suggestion that Dolowy’s product looks the same or similar with the claimed product.** Indeed, there are only evidences showing the contrary. For example, Dolowy teaches that the reinforcing fibers are “of a different material wherein the reinforcing fibers are uniformly distributed in random orientation throughout the matrix (col. 2, lines 3-7). The claimed product, however, does not have reinforcing fibers of a different material wherein the reinforcing fibers are uniformly distributed in random orientation throughout the matrix. The only similarity between the product in Dolowy and the claimed product is that they both are a composite and have metal matrix. **The Examiner fails to overcome the initial burden** that these two products look the same or

similar, not to mention identical.

Thirdly, even if the burden now shifts to the Applicant, there are unobvious differences between the product in Dolowy and the claimed product. For example, the main goal in Dolowy is that the fibers must be uniformly distributed and that the composite must have uniform physical properties in all directions (see col. 1, lines 55-62). In the present application, however, the composite does not need to have uniform physical properties at all. Since the composite is to be put in anti-mine shoes, it would be best that the composite is non-uniform so that its strongest direction is from the bottom to the top. In other words, the most important and distinguishing quality of the prior art product is undesired in the present invention.

The Examiner's logic appears to be that, if all materials of the claimed product can be found in the prior art, and if it is not clear how the claimed product and/or the prior art product looks like, then a product-by-process claim is not patentable, no matter how different the process is from that of the prior art, unless the Applicant provides evidence establishing an unobvious difference between the claimed product and the prior art product, which is difficult because the Applicant does not know what the prior art product looks like. If the Examiner's logic applies, a product-by-process claim will never be patentable, when it is unclear how the claimed product or the prior art product looks like. The Applicant believes that, if all elements of the processes are to be ignored, the Examiner must find clear and convincing evidence (for example, drawings showing that the two products look the same) strongly supporting the conclusion that the claimed product

and the prior art product look the same on the appearance, which the Examiner fails to do in the Office Action.

Due to the reasons stated above, the Applicant respectfully submits that claims 72 and 85 are patentable. Claims 73-84 and 86-94 are also patentable, at least by virtue of their dependency from claim 72 or claim 85.

The Applicant believes that all pending claims should be allowed and reconsideration of the present application is respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account No. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

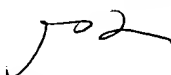
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12/19/2003

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Respectfully submitted,



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